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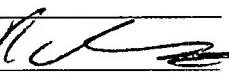
OFFICE OF PETITIONS

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) James J. Rudnick Examiner: Isabella
Application Serial No.: 09/977,823 Group Art Unit: 3738
Confirmation No.: 4655 Docket: 760-84 CON 3
Filed: October 15, 2001 Dated: March 22, 2004
For: NESTED STENT (AS AMENDED)

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
on March 22, 2004*

Signature: Robyn Saunders 

Attn: Mail Stop Petition
Commissioner of Patents & Trademarks
PO Box 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE AN ABANDONED APPLICATION PURSUANT TO
37 C.F.R. §1.137 OR IN THE ALTERNATIVE, A PETITION TO THE COMMISSIONER
UNDER 37 C.F.R. §1.181

Sir:

The applicant respectfully requests revival of the above-referenced application which unintentionally became abandoned by the failure to respond to a restriction requirement mailed January 14, 2002.

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REMARKS

The present application is a continuation of Application Serial No. 09/271,304 filed March 17, 1999, which is a continuation of Application Serial No. 08/708,651, filed September 5, 1996, now, U.S. Patent No. 5,906,639 which is a continuation of Application Serial No. 08/289,791 filed August 12, 1994, now, U.S. Patent No. 5,575,816.

The present continuation application was filed on October 15, 2001. Subsequent to the filing of the present continuation, a Preliminary Amendment pursuant to 37 C.F.R. §1.111 was filed on January 11, 2002 by certificate of mailing. On January 14, 2002, three (3) days after the filing of a preliminary amendment, an office action was issued from the United States Patent and Trademark Office (PTO). This office action was a restriction requirement. The restriction requirement addressed the original claims of the continuation application and not the claims of the previously filed preliminary amendment. In that preliminary amendment, the original claims were canceled and new claims were submitted for consideration. These new claims were not addressed in the restriction requirement.

Immediately upon receipt of the restriction requirement, undersigned counsel contacted Examiner Isabella to discuss the apparent crossing in the mail of the restriction requirement and the preliminary amendment.

Undersigned counsel was informed by Examiner Isabella that the mailing of the restriction requirement was in error and that the Examiner would withdraw the restriction requirement and issue a first office action based on the claims in the preliminary amendment.

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Examiner Isabella specifically informed undersigned counsel that no response need be filed to the preliminary amendment.

Undersigned counsel awaited receipt of a first office action. However, on September 25, 2002, a notice of abandonment was issued by the PTO as a result of a failure to respond to the restriction requirement.

Promptly upon receiving the notice of abandonment and in accordance with MPEP §711.03, undersigned counsel contacted Examiner Isabella by telephone asking for reconsideration and withdrawal of the notice of abandonment stating that there was no abandonment in fact. The Examiner again acknowledged that the application was improperly abandoned and that the Examiner would withdraw the holding of abandonment and issue a first office action based on the claims filed with the preliminary amendment. My conversation with the Examiner is reflected in my letter to the client of October 8, 2002 reporting receipt of the notice of abandonment (copy attached).

On numerous subsequent occasions, I attempted to contact Examiner Isabella to discuss the notice of abandonment. A memo to file dated January 7, 2003 (copy attached) outlines these attempts and the Examiner's continued indication that he would rescind the restriction requirement and his indication that no formal reply need be filed by the applicant.

Having received no further communication from the PTO, a first status request was sent on February 10, 2003 formally requesting the status of the application. Receiving no response to the status request, I again attempted to contact the Examiner by telephone. In a memo to file

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dated June 30, 2003, (copy attached) Examiner Isabella again informed me that a revision of the notice of abandonment would be forthcoming in this case.

Having again received no further communication from the Examiner, a second status request was filed on February 9, 2004. In response to this second status request, on March 9, 2004, undersigned counsel received a telephone call from Supervisory Examiner McDermott. In that telephone conversation, Examiner McDermott indicated that she recognized the difficulties we were having in this case but said the PTO procedures provided no recourse for revision of the notice of abandonment. This is indirect contradistinction to the indication I received on numerous occasions from Examiner Isabella.

As a result of the information provided by Examiner McDermott, the present petition is being submitted.

Applicant respectfully requests that the Commissioner suspend the rules and rescind the notice of abandonment and reinstate the application for examination based on the claims submitted in the preliminary amendment.

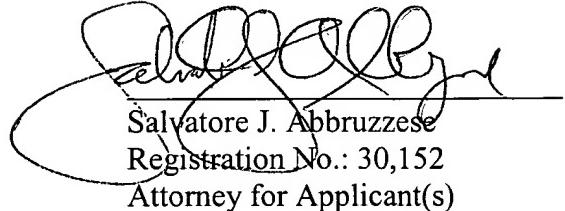
In the alternative, applicant respectfully requests revival of this unintentionally abandoned application.

With respect to any fees necessitated by way of these alternative petitions, including a petition under 37 C.F.R. §1.181 or under 37 C.F.R. §1.137 or with regard to any other fees accorded by this submission, the PTO is authorized to charge such fees to undersigned counsel's deposit account 08-2461.

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Prompt action is hereby respectfully solicited.

Respectfully submitted,



Salvatore J. Abbruzzese
Registration No.: 30,152
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700



HOFFMANN & BARON, LLP

ATTORNEYS AT LAW

CHARLES R. HOFFMANN*
RONALD J. BARON*
DANIEL A. SCOLA, JR.
A. THOMAS KAMMER*
SALVATORE J. ABRUZZESE

ANTHONY E. BENNETT†

GREGORY W. BACHMANN*
MARK E. BARON
STEVEN T. ZUSCHLAG*
SUSAN A. SIPOS
KEVIN E. MCDERMOTT*
RODERICK S.W. TURNER*
ROBERT C. MORRISS*
JOHN S. SOPKO
JUSTIN K. HOLMES*

ALGIS ANILIONIS, Ph.D*
CHRISTINA L. WARRICK
LUDOMIR A. BUDZYN
ANNA-LISA GALLO
LAUREN T. EMR*
JOY I. FARBER*
JAMES F. HARRINGTON*
VELLY B. POLYCARPE*

PATENT AGENTS
GLORIA K. SZAKIEL, Ph.D. ROHINI K. GARG
LINDA T. PARKER, Ph.D. EDNA I. GERGEL, Ph.D.

1055 PARSIPPANY BLVD.
PARSIPPANY, NEW JERSEY 07054
(973) 331-1700
FACSIMILE (973) 331-1717
www.hoffmannbaron.com

NEW YORK OFFICE
6900 JERICHO TURNPIKE
SYOSSET, N.Y. 11791
(516) 822-3550
FAX (516) 822-3582

OF COUNSEL
ROBERT M. RODRICK

SCIENTIFIC ADVISOR
DANIEL A. SCOLA, SR., Ph.D.

* NOT ADMITTED IN NJ
† SENIOR ATTORNEY

October 8, 2002

Luke R. Dohmen, Esq.
Vice President and Chief Patent Counsel, Cardiology
Boston Scientific/SCIMED Life Systems, Inc.
One SCIMED Place
Maple Grove, MN 55311-1566

Re: U.S. Patent Application No. 09/977,823
NESTED STENT
Meadox Medicals, Inc.
Meadox Reference: 94-P0266 CON-3
Our Docket: 498-67 CON 3

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Dear Luke:

We have received a Notice of Abandonment from the U.S. Patent and Trademark Office with regard to the above-identified application. A copy of this Notice of Abandonment is enclosed for your records.

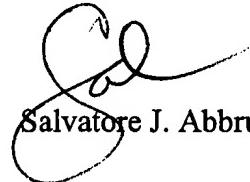
Initially, let me state that we are of the opinion that this Notice of Abandonment was issued in error. As you will recall from my correspondence of January 18, 2002, we received a restriction requirement from the U.S. Patent and Trademark Office. This restriction requirement crossed in the mail with a previously filed Preliminary Amendment. The Preliminary Amendment would have obviated the need for the restriction requirement. Immediately upon receiving the restriction requirement, I called Examiner Isabella. At that time, Examiner Isabella agreed to withdraw the restriction requirement in view of the Preliminary Amendment.

Once I received the present Notice of Abandonment, I again called Examiner Isabella. He informed me that the Notice of Abandonment was sent in error. He will arrange to rescind the Notice of Abandonment and issue an Office Action on the claims in the Preliminary Amendment. The Examiner is expected to do this on his own initiative and no further papers will be necessary from us at this time. However, the Examiner stated that if a paper, such as a Request for Withdrawal of Notice of Abandonment is necessary, he will contact us.

Luke Dohmen, Esq.
October 8, 2002
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We will keep you advised of all developments with regard to the prosecution of this application. If you need anything further, please do not hesitate to contact us.

Very truly yours,



Salvatore J. Abbruzzese

SJA/mjm
Enclosure



MEMORANDUM

TO: FILE

FROM: SJA

DATE: January 7, 2003

RE: 498-67 CON 3

SJA

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I again called Examiner Isabella to check on the status of this case. I informed him of the history of the case, namely that the Preliminary Amendment I filed in this case was mailed prior to the mailing of the Examiner's restriction requirement. The Preliminary Amendment obviated the need for the restriction requirement inasmuch as the Preliminary Amendment cancelled the claims which were the subject matter of the restriction requirement and added new claims.

I called Examiner Isabella to inform of this fact. He told me that he would rescind the restriction requirement and issue a first Office Action. I also asked him at this time if he needed any formal reply and he said no. However, subsequent to this conversation, we received a Notice of Abandonment from the USPTO as a result of failure to respond the restriction requirement.

I again called Examiner Isabella and informed him of the Notice of Abandonment. He said it was a Patent Office error and would rescind the Notice of Abandonment. He again stated that I need not file a paper.

I have called him several times thereafter as a follow-up. Each time the Examiner said he would look into it, but did not have the file at hand.

I again called him today and he apologized for the delay and said he would look into it immediately and get back to me.

SJA/mjm

Called left message w/ Isabellae 2/4/03 8m
Called left message w/ Isabellae 2/6/03 8m



MEMORANDUM

TO: 760-84 CON3
FROM: SJA *SJA*
DATE: June 30, 2003

I spoke today with Examiner Isabella concerning the above-identified application. I noted to the Examiner that I have not received a rescission of the Notice of Abandonment nor an office action in this case. He looked up the case and found that it has been filed in the Patent Repository and that a rescission of the Notice of Abandonment should be issued. He will immediately order the case, issue the rescission of the Notice of Abandonment, and place the application in status to be examined. He said he would have some further information to me tomorrow afternoon.

In view of that information, I will hold off filing the Supplemental Information Disclosure Statement until the application is back in the hands of the Examiner.

SJA/lpc

Called Isabella 1/20/04 SM

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